REMARKS

Prosecution Summary. In light of the USPTO's current policies on compact prosecution, it is noted that the pending application was filed more than five years ago on October 24, 2003 with 25 claims. The first office action was filed three years nine months later on July 24, 2007. The presently addressed sixth office action was mailed January 29, 2010.

Claim Summary. Claims 1-25 are pending. Claims 1, 8, and 16 are independent. Although believed to be unnecessary as discussed below, claims 1, 8 and 16 are amended in accordance with the request of the Examiners during a telephone conversation to move forward to allowance as quickly as possible.

Office Action Summary. Previous rejections are withdrawn, but the claims are rejected on new grounds. Claims 1-25 are rejected under 35 U.S.C. 35 § 103(a).

Remarks summary. Applicants respectfully traverse the objections and rejections. As explained in detail below, it is respectfully submitted that the claims are allowable over the newly asserted art. The arguments underlying the rejection are clearly erroneous. Reconsideration and withdrawal of the rejection in view of the following remarks is respectfully requested.

References to the Pending Application. Reference to paragraphs in the pending application are to the numbered paragraphs in the Published Application No. 2005/0091168.

Telephone Conversation With Examiners

Examiner Murdough and Supervisory Examiner Fischer are thanked for the telephone conversation conducted on April 7, 2010. Differences between claimed subject matter and asserted art were discussed. Clarifying amendments were discussed. Although no agreements were reached, it appears that the clarifying amendments will overcome the rejections based on the asserted art.

Applicants representatives and the Examiners discussed proper interpretation of "a license for a computer program subject to use under a plurality of licenses each permitting different rights in the computer program." The computer program is the subject matter that is licensed via any of a plurality of different licenses each providing different rights in the licensed computer program. The common licensing component exposes a callable interface to the licensable computer program itself. The computer program calls the callable interface and provides an identifier of a right to (a) find out if it can be exercised and (b) obtain information per a license.

The claims do not state that there are different programs (different versions) or different users. The claims state that the different licenses give different rights in the same program. Regardless of these different licenses, the same common licensing component/service is called by the licensable program itself to determine if rights can be exercised and to obtain information for the different licenses.

The Examiners suggested inserting "the same instance of" the computer program. It should be considered that each instantiation of the program can be subject to a different license and the common licensing component can be called by more than one instantiation. For example, user 1 may have license A specifying set of rights A for the program and user 2 may have license B specifying set of rights B for the program, each having a different instantiation of the same program such that each instantiation calls the same common licensing component. Likewise, the same user may have licenses A and B applicable to one or more instantiations. Introducing instantiation into the claims to reinforce the point that the same licensable computer program is subject to use under a variety of licenses with different rights should not introduce limitations on use of the common licensing component by multiple instances of the program.

Rejection of Claims* 1-25 *under 35 U.S.C. § 103(a)

Claims 1-25 are rejected under 35 U.S.C. 35 § 103(a) as unpatentable over U.S. Patent No. 6,047,242, issued to Benson (hereinafter referred to as "Benson") in view of U.S. Patent No. 5,629,980, issued to Stefik et al. (hereinafter referred to as "Stefik") and also, only with respect

to claims 2, 6, 7, 15, 19 and 21-23, U.S. Patent Application Publication No. 2003/0088516, by Remer et al. (hereinafter referred to as "Remer"), and also only with respect to claims 4, 11-14, 18, 24 and 25, U.S. Patent No. 6,115,777, issued to Zahir et al. (hereinafter referred to as "Zahir"). (Office Action, pp. 2-10). Applicants respectfully traverse.

All three independent claims 1, 8, and 16 are rejected using the same argument on pages 2-4 of the Office Action.

Benson and Stefik pertain to a different type of rights enforcement than the claimed subject matter and, as a result, fail to teach or suggest any claim limitations. The following remarks highlight several limitations that the references fail to teach or suggest.

First, the citation "Figure 3," which is an ambiguous pseudo-argument citation, does not teach or suggest that Benson's software 103 is subject to a plurality of licenses permitting different rights in software 103, which is required by the claims. Benson discusses FIGS. 1-3 thusly:

> FIG. 1 shows a purchasing protocol used when a customer 102 wishes to purchase software that is protected by an ECP (electronic copy and license protection) mechanism in accordance with the present invention. The vendor 101 has public and private keying material used for digital signatures; and each potential customer 102 has public and private keying material used for asymmetric proof protocols. Each party makes its public keying material available to other parties, but keeps its private keying material secret.
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> In step 1, the customer 102 obtains the protected software 103 from a vendor 101 by downloading the software from a network bulletin board. A challenge mechanism 24 (cp. FIG. 2), to be described later in detail, is embedded in the protected software 103 in such a way that a potential attacker cannot easily separate the challenge mechanism 24 from the protected program 103. The attacker would need to disassemble the code and to manually remove the challenge mechanism. The challenge mechanism 24 has the vendor's public keying material embedded in it. As will be described, the challenge mechanism 24 prevents the customer from running the software at this stage. The entire protected program, including the challenge mechanism is signed using the vendor's private keying material.

> In step 2, the customer 102 sends a registration package 104 to the vendor 101 by electronic mail. The registration package 104 contains a reference to a public directory that holds the customer's public keying material.
>
> In step 3, the software vendor 101 locates the customer's public keying material and embeds the customer's public keying material into a keyfile 105 and sends the keyfile 105 to the customer 102 by electronic mail. Once the customer 102 installs the keyfile, the protection mechanism permits the customer 102 to execute the protected software 103 provided that the customer can prove that he or she has access to the customer's private keying material.

Benson, col. 10, ll. 20-54.

> FIG. 2 shows the software components that are required to be installed in the customer's machine, such as a computer, to enable the customer to run the protected software 103 after the mutual authentication. These consist of a license server 20, the keyfiles 105, the protected software 103, and the certificates (not shown). The protected software 103 includes a challenge mechanism 24 and possibly a response mechanism (not shown). The license server accesses private keying material (not shown). In the case that the protected program includes a response mechanism, then the protected program's response mechanism accesses secret keying material.
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> The license server 20 is a program that the customer 102 executes when the system initially boots. The customer 102 enables the system by inserting a smart card that contains the customer's private keying material. The license server 20 then prompts the customer 102 for a pass phrase used to enable the smart card. The license software does not execute if the customer cannot supply the correct pass phrase to unlock the smart card.

Benson, col. 14, ll. 5-22.

Nowhere does Benson teach or suggest that software 103 is subject to use under a plurality of licenses each permitting different rights in software 103. Further, although not cited, the fact that Benson states in column 16, lines 64-66 that a plurality of customers, each with their own copy of software 103 could share license server 120 also does not teach or suggest that software 103 is subject to a plurality of licenses each permitting different rights in software 103.

Further still, although not cited, at column 2, line 66 – column 3, line 8, Benson discusses rights in a license, not different rights in different licenses for the same software.

In accordance with software 103 being subject to one license, all that Benson's license server 20 does is confirm that the customer has access to the private key counterpart to the public key embedded in keyfile 105. If the customer proves he/she has access then the customer can use the software according to the license.

Second, at column 16, lines 64-66, Benson only states that a plurality of customers, each with their own copy of software 103 could share license server 120. This clearly does not teach or suggest that software 103 is subject to a plurality of licenses each permitting different rights in software 103 or that ECP (the alleged licensing component) is common to a plurality of licenses each permitting different rights in the software as required by the claims. In other words, all the Office Action cites to is ECP can be common to a plurality of licenses, but not to a plurality of licenses each with different rights in the software, which is what the claims require.

Third, Benson's statement in column 2, line 66 to column 3, line 8, that when a license is granted by a license server the license server modifies an access control list (ACL) to permit licensed software to access a file does not remotely teach or suggest as required by the claims (i) that a license comprises an ACL or (ii) an information-retrieval (I-R) component in a callable interface, let alone the claimed I-R component that receives an identifier of a right from a licensed program and in return provides information associated with the right to the licensed program. Nothing like that is disclosed by Benson.

(i) An ACL controlled by license server 20 does not make an ACL part of a license. Rather, the ACL is modified to add the customer to it in accordance with a license to access a resource.

(ii) The claims specify that the I-R component is part of the callable interface. The Office Action equated Benson's challenge mechanism 24 to the claimed callable interface.

Therefore, the Office Action is required to cite a part of challenge mechanism 24 to even begin to make an argument. However, Benson's server 20 is not part of its challenge mechanism 24. Instead, the Office Action cites Benson's server 20 as the claimed license store.

Where are the ACL and file Benson refers to? Benson does not say and therefore does not teach and, besides, it doesn't matter because an ACL doesn't operate as argued. The server controlling the ACL merely grants or denies access to a controlled resource (file) based on the ACL; it doesn't return the ACL in response to attempts to access the file.

Fourth, the claims require that a callable interface be exposed to the licensed program to provide licensing information to it. Benson's challenge mechanism 24 is not callable by protected software 103. The Office Action seems to assume this, but nowhere cites any teaching or suggestion in Benson to prove it. Challenge mechanism 24 is an enforcer, not a provider of licensing information to software 103.

Fifth, the Office Action turns to Stefik with respect to the claimed right-consumption component. An obvious problem with Stefik is that what is alleged to be a right consumption component (e.g. Stefik's repository 1) does not receive an identifier of a right from the digital work itself, which the claims require. Instead, for example as shown in FIG. 1 and discussed with regard thereto, Stefik's repository 1 receives a request from repository 2 to access the digital work. The alleged right-consumption component does not receive an identifier from the digital work. The Office Action doesn't cite any portion of Stefik regarding this detail and appears to have overlooked it in the claims.

Furthermore, the Office Action's block citation to 10 columns in Stefik is improper. The Examiner cannot essentially tell Applicants, look, somewhere in these ten columns you might find whatever it is I'm thinking. Such massive block citations are far too ambiguous to be useful during prosecution.

Sixth, the Office Action fails to explain how it would have been obvious to inject Stefik's repository 1 or FIG. 15 usage rights grammar into Benson's challenge mechanism 24 when it isn't even a callable interface. The Office Action fails to present a prima facie rejection by merely concluding it is obvious to combine tens columns from Stefik with Benson. Combine precisely what elements and how? How is that technically done? What is the technical functionality after the combination/modification?

It may be helpful to consider the big picture. A reason why the claims specify a callable interface to the licensed program to provide it with licensing information, is that the program can enforce a license. In contrast, neither Benson nor Stefik allow this. In Benson, challenge mechanism is an enforcer that allows or permits use. In Stefik, repository 1 using rights grammar FIG. 15 is the enforcer. In these references, there's no point to providing a callable interface to provide licensing information to the licensed program.

The foregoing remarks rebutting the rejection of claim 1 apply in whole to the rejection of claims 2-7 and at least in part to the rejection of claims 8 and 16, and all claims depending thereon.

For at least the foregoing reasons, it is respectfully submitted that the arguments in the Office Action clearly lack merit. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-25.

CONCLUSION

Any amendments made during prosecution of the pending application are without abandonment of subject matter. Applicants expressly reserve the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested.

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